

REMARKS

Applicants have studied the Office Action dated March 16, 2004. Applicants have amended claim 12 for grammatical purposes only. No new matter has been added. It is submitted that the application, is in condition for allowance. By virtue of this amendment, claims 1-18 are pending. Reconsideration and further examination of the pending claims in view of the above amendments and the following remarks is respectfully requested. In the Office Action, the Examiner:

- (1) Rejected claim 18 under 35 U.S.C. §112, first paragraph, as failing to comply with enablement requirement;
- (2) Rejected claims 1-17 under 35 U.S.C. 102(e) as being anticipated by Serbinis et al. (U.S. Patent No. 6,314,425 B1); and
- (3) Rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al. (U.S. Patent No. 6,314,425 B1), in view of Official Notice.

Overview of the Current Invention

Preferred Embodiments of the present invention provide an improved system, computer readable medium, and apparatus for centrally managing documents in a client server system. The system includes database, a voice response system and a fax reception system to a telecommunications network. The present invention provides a novel combination of affordable scanning technology available through client fax machines, client telephone handsets, with web browsing to provide a centralized document storage and retrieval solution. Unlike prior art systems, the documents are loaded onto the centralized database storage using a fax machine and information or metadata which is associated with voice response. This combination makes it very easy for users to store fax images of documents in a database which is searchable by category and other user associated metadata. Turning to the summary of the present invention with emphasis added:

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A user through the voice response system, provides a login request over the telecommunications network using a fax machine with a telephone. The system checks to determine if the user has an account, and if the user does not have an account setting up an account with the user over the telecommunications network. Next, the user via the voice response system provides a category to be associated with a document to be faxed from the user. The user faxes a document to be stored in the database that is associated with a category under an account for the user. To retrieve a document previously faxed for storage, the information relating to the document is searchable and the document can be faxed back to the user's fax machine.

In order to more particularly point out this feature of using a centralized database storage using a fax machine and information or metadata is associated with voice response, the relevant language in the claims has been emphasized in the independent claims, i.e., claims 1, 10, 12, 14, and 16 as follows:

Claim 1. A method for centrally managing documents in a client server system comprising the steps of:

coupling to a server system with a database, one or more client systems over a network;

linking the server to a telephone system;

receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;

receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received;
and

storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

Claim 10. A method for centrally managing documents in a client server system comprising the steps of:

coupling to a server system with a database to a telephone system;
receiving at least one identifier over the telephone system for a document to be stored from a user's fax machine in the database;
receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received;
and
storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

Claim 12. A business method for centrally managing documents in a client server system comprising the steps of:

coupling to a server system with a database, a voice response system and a fax reception system to a telecommunications network;
using the voice response system, receiving a login request from a user over the telecommunications network using a client network unit;
determining if the user has an account and if the user does not have an account setting up an account with the user over the telecommunications network;
using the voice response system prompting the user for a category to be associated with a document to be faxed from the user using a voice response; and
receiving a fax from the user of a document to be stored in the database that is associated with a category under an account for the user.

Claim 14. A computer readable medium containing programming instructions for centrally managing documents in a client server system, the programming instructions comprising:

coupling to a server system with a database to a telephone system;
receiving at least one identifier over the telephone system for a document to be

stored from a user's fax machine in the database;

receiving a fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to the at least one identifier received;
and

storing the fax reception of the at least one document with the at least one identifier in the database, wherein the identifier associated with the at least one document and the identifier is capable of being searched in the database.

Claim 16. A central fax storage and retrieval system for centrally managing documents over a telecommunications network:

a server coupled to a telecommunications network;

a fax receiver coupled to the server for receiving faxes sent from a user's fax machine;

a telephone voice response system coupled to the server, the telephone response system having pre-recorded message prompts and voice recognition software for receiving user selections of the prerecorded message prompts, and the telephone response system receiving a message identifying a user; and

a database coupled to the server, the database capable of storing electronically faxes received from the user's fax machine along with user information including user selections and user identification.

(1) Rejection Under 35 U.S.C. §112, First Paragraph

As noted above, the Examiner rejected claim 18 under 35 U.S.C. §112, first paragraph, as failing to comply with enablement requirement. The language the Examiner is questioning is support for "*a speech to text conversion*". The Applicant respectfully traverses this rejection. IVR, speech recognition and voice recognition are used interchangeably in the present invention with "*a speech to text conversion*". The term "*a speech to text conversion*" as suggested by the Examiner on page 2 of the Office Action is used as known in the art and was not *ipsis verbis* (not in the identical words) in the

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specification.¹ The Examiner is respectively reminded that this was sufficiently described in the specification as originally filed albeit not in the identical words, as follows:

Page 5: (Emphasis Added)

The database server is coupled to an interactive voice response (IVR) system 118 with voice recognition, such as the IBM Direct/Talk 6000™ line of products. In addition, the database server 106 contains fax module 116, for receiving facsimile transmissions such as those WinFax brand fax modules. Although the database server 106 is shown as one unit containing the components of voice recognition 114, IVR 116 and fax 118, any and all combinations of these modules may be implemented external to the database server 106.

An exemplary database server 106 with components of voice recognition 114, IVR 116 and fax 118 has been shown to be used advantageously with the present invention is described in U.S. Pat. No. 5,471,521 with inventors Minakami et al., issued November 28, 1995, entitled "Distributed system for call processing" which is commonly assigned herewith to International Business Machines and is incorporated herein by reference in its entirety.

¹ "If, on the other hand, the specification contains a description of the claimed invention, albeit not in *ipsis verbis* (in the identical words), then the examiner or Board, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient." See *In re Alton* (Fed. Cir. 1996) (Emphasis Added). See also *Fujikawa v. Wattanasin* (Fed. Cir. 1996), *ipsis verbis*, "...as the Board recognized, however, *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question." *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). See MPEP 2163 subsection II 3 (a), second to last paragraph.

Page 8 (Emphasis Added)

In another embodiment the categories, are suggested to the user depending on the payee. For example, the voice recognition component with the application 308 software recognizes that A.T.&T. is a utility category of telephone.

In another embodiment, the IVR 116 component and the voice recognition 114 component can be adjusted to account for the different geographies from which a user may dial-in to the database server 106. The system disclosed in U.S. Pat. No. 5,524,169, with inventors Cohen et al., issued June 4, 1996, entitled "Method and system for location-specific speech recognition" which is commonly assigned herewith to International Business Machines" may be used advantageously with the present invention.

In view of the foregoing, the Applicant submits that the support for "a speech to text conversion" is adequately described in the specification to enable one of average skill in the art to understand the meaning. Further, as the Examiner states, this term is known in the art. No new matter has been added. The Applicant respectfully requests that the Examiner's objection be withdrawn.

(2) Rejection Under 35 U.S.C. §102(e)

As noted above, the Examiner rejected claims 1-17 under 35 U.S.C. 102(e) as being anticipated by Serbinis et al. (U.S. Patent No. 6,314,425 B1). The Applicant respectfully traverses this rejection. The Examiner at pp. 2-3 of the office action states "*Serbinis teaches a method [...] from a user's fax machine (col. 7, lines 58-65, teaches utilization of a system in an environment) in the database; receiving fax reception over the telephone system from at least one user's fax machine of at least one document corresponding to an identifier...*". However, careful reading of Serbinis discloses a fax

notification from the document management system, not a fax reception to the document management system. Or in the words of Serbinis at col. 7, lines 59-65 (Emphasis Added).

Notification information tables 66 maintain information necessary to generate a notification message, and include entries for: notification transport type, i.e., e-mail, facsimile, voice, or pager; information on the status of the notification, i.e. pending, sent, failed; the recipient's notification identification; priority information; and optionally, the scheduled date/time for delivery.

col. 19, lines 39-50 (Emphasis Added)

Notification Processes

Referring now to FIGS. 12A and 12B, the notification request and confirmation services available on a preferred embodiment of DMS system 17 are described. Notification messages are generated by notification server 35 in response to various user events. For example, when a registrant registers for a DMS service, the registrant receives a notification with instructions on authorization, as discussed hereinabove with respect to step 178 of FIG. 9.

As another example, when an Originator has created an electronic document and uploaded that document to the DMS system, Authorized Users having access to the document may receive a notification that the document is available to be retrieved (as discussed with reference to steps 108 and 114 of FIG. 5). In this case, the notification may contain instructions on how the document may be retrieved from the DMS system. The notification messages are digital and may take the form of an alphanumeric message, digital sound, digital image or other digital forms. DMS system 17 therefore preferably supports several types of notification transports including e-mail, fax, voice messaging and pager.

In fact, there are only two places in the entire Serbinis reference referring to facsimile or fax as quoted above. Accordingly, the notification of users by fax from the DMS as explicitly described by Serbinis is not the same as receiving a document to be stored by fax. The Applicant respectfully submits that the Examiner is technically confounding transmission by the DMS of a fax notification with reception of a document for storage by fax.

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Serbinis.² The elements in independent claims 1, 10, 12, 14, and 16 recite "receiving a fax reception" and "storing the fax reception" on the centralized database for later retrieval. Accordingly, the present invention distinguishes over Serbinis for at least this reason. The Applicant respectfully submitted that the Examiner's rejection under 35 U.S.C. § 102(b) has been overcome.

For the foregoing reasons, independent claims 1, 10, 12, 14, and 16 distinguish over Serbinis. Claims 2-9, 11, 13, 15, and 17 depend from claims 1, 10, 12, 14, and 16. Since dependent claims contain all the limitations of the independent claims, claims 2-9, 11, 13, 15, and 17 distinguish over Serbinis, as well.

(3) Rejection Under 35 U.S.C. §103(a)

As noted above, the Examiner rejected claim 18 under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al. (U.S. Patent No. 6,314,425 B1), in view of Official Notice. Independent claim 16 for the reasons above distinguishes over Serbinis

² See MPEP §2131 (Emphasis Added) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim."

because Serbinis is completely silent on

a fax receiver coupled to the server for receiving faxes sent from a user's fax machine;

a telephone voice response system coupled to the server, the telephone response system having pre-recorded message prompts and voice recognition software for receiving user selections of the prerecorded message prompts, and the telephone response system receiving a message identifying a user; and

a database coupled to the server, the database capable of storing electronically faxes received from the user's fax machine along with user information including user selections and user identification.

The Examiner goes on to combine Serbinis with Official Notice.³ The Examiner recites 35 U.S.C. §103. The Statute expressly requires that obviousness or non-obviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the present invention is giving full recognition to the invention "as a whole." The Serbinis reference expressly teaches away from receiving a document for storage via fax and instead describes notification via fax. Accordingly, independent claim 16 distinguishes over Serbinis and/or Official Notice for at least this reason.

Further, under MPEP § 2144.03, where the Examiner takes official notice on facts outside the record and "when a rejection is based on facts within the personal knowledge" of the Examiner the Applicant may require an affidavit from the Examiner to support such personal knowledge. The Applicant respectfully requests such an affidavit from the Examiner to put these facts on the record.

Independent claim 16 distinguishes over Serbinis. Claim 18 depends from claim 16. Since dependent claims contain all the limitations of the independent claims, claim 18

³ Applicant make no statement whether such combination is even proper.

distinguishes over Serbinis, as well.

CONCLUSIONS

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as previously amended.

In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith to the disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §§ 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

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PLEASE, if for any reason the Examiner finds the application other than in condition for allowance, the Examiner is invited to call either of the undersigned attorneys at (561) 989-9811 should the Examiner believe a telephone interview would advance the prosecution of the application.

Respectfully submitted,

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